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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,922	10/19/2001	Junmyoung Song	2777-0193P	6320

2292 7590 12/18/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

009

Advisory Action	Application No. 09/981,922	Applicant(s) SONG ET AL.	
	Examiner Marc A Patterson	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

THE REPLY FILED 18 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-5.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached.

ADVISORY ACTION

Applicant's arguments filed November 18, 2003 have been fully considered but have not been found to be persuasive.

1. Applicant argues on page 5 of Paper No. 9 that newly submitted Claim 7 is based on the specification, and that no new matter is added. However, the claims prior to amendment were not directed to 'a metal salt of stearic acid of 0.01 – 1.0 weight percent' or a polybutylene terephthalate resin which contains 'pigment of 10 – 30 weight percent.' The amendment therefore raises new issues, which to be completely addressed would require further search and consideration, and the amendment has therefore not been entered. Even if the amendment was entered, the amended claim would not overcome the rejection, because as stated on page 3 of the previous Action, Kuze et al teach a polyester composition comprising 100% by weight of a copolymer of polyethylene terephthalate, polyethylene naphthalate and polybutylene terephthalate (column 2, lines 31 – 51) and a metal salt of benzoic acid (potassium benzoate; column 3, line 57) for the purpose of obtaining a composition having excellent slip properties (column 1, lines 8 – 20). The desirability of providing for 100% by weight of a copolymer of polyethylene terephthalate, polyethylene naphthalate and polybutylene terephthalate, and a metal salt of benzoic acid in Shikama et al, which is a polyester composition, would therefore be obvious to one of ordinary skill in the art.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a metal salt of benzoic acid in Shikama et al in order to obtaining a composition having excellent slip properties as taught by Kuze et al.

Applicant also argues on page 5 that with regard to Claim 1, Shikama et al disclose a tubing which is formed from a resin having PPS as the main ingredient, and that polyester is used below 30% by weight. However, a tubing which comprises 30% by weight polyester or more is not claimed.

Applicant also argues on page 5 that with regard to Claim 1, Shikama et al fail to disclose a tube which comprises a copolyester. However, Claim 1 is clearly directed to a tubing which comprises either a polyester or copolyester and therefore does not exclude Shikama et al.

Applicant also argues, on page 6 that the slipperiness disclosed in the present invention is valid only by the composition of the invention. However, as stated on page 3 of the previous Action, Shikama discloses the use of particles, as required, to provide slipperiness (column 3, lines 55 – 67). Therefore, the slipperiness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the slipperiness, since the slipperiness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Shikama et al, in the absence of unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant also argues on page 6 that Kuze et al teach the use of titanium dioxide as a fine particle to enhance slipperiness, rather than as a pigment. However, titanium dioxide is also a colored particle, and is therefore a pigment.

Applicant also argues on page 6 that Kuze et al teach the use of a metal salt for enhancement of the effect of external particle, whereas in the claimed invention it is used for

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control of crystallization rate. However, the claimed invention reads on Kuze et al, as Kuze et al teach the use of a metal salt and the intended use of the salt is given little patentable weight.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

Marc Patterson
Art Unit 1772


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/16/03